

**Application No. 09/841,465  
Attorney Docket No. 2000522.125 US2  
Reply to Office Action of September 30, 2005**

**Amendments to the Drawings**

The attached sheets of drawings includes changes to FIGS. 2, 7, 8, 10, and 13. These sheets, which include FIGS. 2, 7, 8, 10, and 13, replace the original sheets including FIGS. 2, 7, 8, 10, and 13.

Attachments: Replacement Sheets  
Annotated Sheets Showing Changes

## **REMARKS**

### **I. Summary of Office Action**

Claims 1-21 are now pending in the application.

The Examiner rejected claims 1-7, 9-13, and 15-19 under 35 U.S.C. § 102(e) as being anticipated by Picco et al. U.S. Patent No. 6,029,045 (hereinafter “Picco”).

The Examiner rejected claims 20 and 21 under 35 U.S.C. § 102(e) as being anticipated by Ngo et al. U.S. Patent No. 6,574,793 (hereinafter “Ngo”).

The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Picco in view of Ngo.

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Picco in view of Kunkel et al. U.S. Patent Application Publication No. 2002/0056093 (hereinafter “Kunkel”).

The Examiner objected to the drawings as failing to comply with 37 C.F.R. §§ 1.84(p)(4) and 1.84(p)(5).

The Examiner objected to the specification as containing certain informalities.

### **II. Summary of Personal Interview**

On November 17, 2005, Examiner Scott Beliveau, Examiner Chris Parry, David Lowry (Registration No. 38,583), Jeremy Rosenberg (Vice President of Visible World, the assignee), and the undersigned conducted an interview at the United States Patent and Trademark Office on the merits of the above-identified patent application. Applicants and the undersigned wish to thank the Examiners for the courtesies extended during the interview.

The undersigned has reviewed the Examiners’ remarks in the Interview Summary mailed on November 17, 2005. Applicants acknowledge that, during the November 17, 2005 Interview, the undersigned (along with David Lowry and Jeremy Rosenberg) discussed with the Examiners the patentability of independent claims 1, 16, and 19 with respect to Picco and the patentability of independent claims 20 and 21 with respect to Ngo. Applicants provided a demonstration of the Visible World message assembly system which utilizes subject matter of the above-identified patent application.

### **III. Summary of Applicants' Reply**

Applicants have amended independent claims 1, 16, 19, 20, and 21 in order to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

Applicants have also amended the specification and the drawings to correct typographical errors and other informalities.

The Examiner's rejections of the claims are respectfully traversed.

Reconsideration of this application is respectfully requested.

### **IV. The Objection to the Drawings**

The Examiner objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5) because they include reference characters not mentioned in the specification. In response to the Examiner's objection, applicants have amended the drawings to remove these reference characters.

The Examiner also objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(5) because they do not include reference characters mentioned in the specification. In response to the Examiner's objection, applicants have amended the drawings to include these reference characters.

The Examiner also objected to the drawings for failing to comply with 37 C.F.R. § 1.84(p)(4) because "reference character '60' has been used to designate both TV and Output Data Stream" and "reference character '58' has been used to designate both STB and Resulting Data Stream." (See Office Action, page 3.) In response to the Examiner's objection, applicants have amended the drawings and the specification to correct these reference characters.

Accordingly, applicants respectfully request that the amendments to the drawings and the specification be entered and that the objections thereto be withdrawn.

### **V. The Objection to the Specification**

The Examiner objected to the specification as containing certain informalities. In particular, the Examiner required that applicants amend the specification to replace the word "thee" with "the" on page 4, line 2 and the word "overlaid" with "overlaid" on page 15, lines 8 and 12. The specification has been amended to correct these informalities and to correct other

typographical errors. No new matter has been added and the amendments are fully supported by the originally filed application.

Accordingly, applicants respectfully request that the amendments to the specification be entered and that the objection thereto be withdrawn.

## **VI. The Rejection of Claims 1-7, 9-13, and 15-19 Under 35 U.S.C. § 102(e)**

The Examiner rejected each of pending claims 1-7, 9-13, and 15-19 under 35 U.S.C. § 102(e) as being anticipated by Picco. The Examiner's rejection of these claims under this section is respectfully traversed.

Applicants respectfully submit that, contrary to the Examiner's contention, each of claims 1-7, 9-13, and 15-19 is allowable for at least the reasons set forth below.

### **A. Applicants' Independent Claim 1 is Allowable Over Picco**

As described in applicants' specification, the invention is directed to at least the problem of providing "a system for the simultaneous creation/production, delivery/transmission, and assembly of synchronous multiple personalized messages to specific targeted individuals, households, or other entities." (See, e.g., Applicants' specification, paragraph [0009].) At least one aspect of the invention is addressed to, for example, the problem that "no advertiser is going to create/produce many different versions of one and the same message, simply because there is no time and/or resources to create the required diversity. The nature of video production, focused typically on one sequential video story, does not allow for incremental content changes. This forces advertisers to avoid topically relevant information and offerings." (See, e.g., Applicants' specification, paragraph [0007].) To overcome these problems, the present invention permits, *inter alia*, allowing the creation of a plurality of non-interactive personalized messages to be viewed by an intended audience.

More particularly, applicants' independent claim 1 accomplishes this by performing the following:

creating a personalized message template comprising a plurality of slots in sequence, wherein a plurality of different segments are insertable into at least one of said slots;

providing a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of segments for said at least one of said

slots, wherein said segments are synchronized to begin and end at substantially the same time; and

providing content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized segments, to allow said receiving unit to select among said plurality of data streams for one of said segments for said particular slot, to assemble a non-interactive personalized message.

Picco, on the other hand, does not make any mention of either the problem of, much less the solution for, how to provide “a system for the simultaneous creation/production, delivery/transmission, and assembly of synchronous multiple personalized messages to specific targeted individuals, households, or other entities.” Instead, Picco discusses methods and systems for inserting local content data (completed advertisements) into a local content space in a programming data stream. (*See, e.g.*, Picco, column 3, lines 43-53.) More particularly, as explained in column 13, line 66 through column 14, line 13 and FIG. 10, in Picco, “the set-top box determines if a local content space in the programming data has been encountered.” “If a local content space has been detected, . . . the set-top box determines, based on the user preferences and the content profiles of the pieces of local content stored on the disk, which piece of local content is going to be inserted into the programming data stream.”

Applicants respectfully submit that, contrary to the Examiner’s contention, Picco does not show or suggest the method of independent claim 1 for at least the reasons set forth below.

(i) **Picco Does Not Show or Suggest Assembling A Non-Interactive Personalized Message**

Claim 1 recites “allow[ing] said receiving unit to select among said plurality of data streams for one of said segments for said particular slot to assemble a non-interactive personalized message.”

In contrast to applicants’ claimed invention, Picco does not show or suggest assembling a non-interactive personalized message. Instead, Picco describes that “[w]ithin each PID, there is a television signal that includes a data stream containing the television programming data and a local content space. The local content space is typically a blank spot in the data stream where an operator of the satellite system may add local content into the data stream.” (*See* Picco, column 5, lines 49-54.) The blank spot in the data stream allows “advertisers who wish to have the satellite operator include their local content (i.e., advertisements) in the television signal being

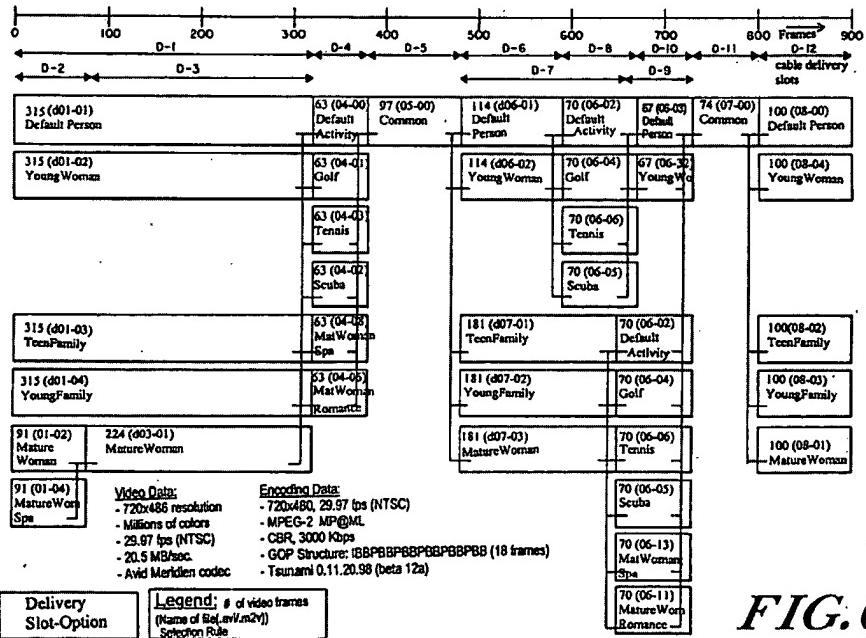
transmitted by the satellite.” (*See* Picco, column 7, lines 2-6.) When the set-top box detects that a local content space has been encountered, it inserts “local content (i.e., advertisements)” into that local content space. This is also apparent from the example provided in Picco at column 6, lines 34-40:

“For example, a user may be looking to buy a new car and may select the preferences that are set so that the set-top box for the user stores only local content (i.e., advertisements) about automobiles. Then, when a local content space within the compressed digital stream is identified, an automobile advertisement is shown to the user.”

Thus, nowhere in Picco is it shown or suggested that assembly of a non-interactive personalized message is performed, as recited in claim 1.

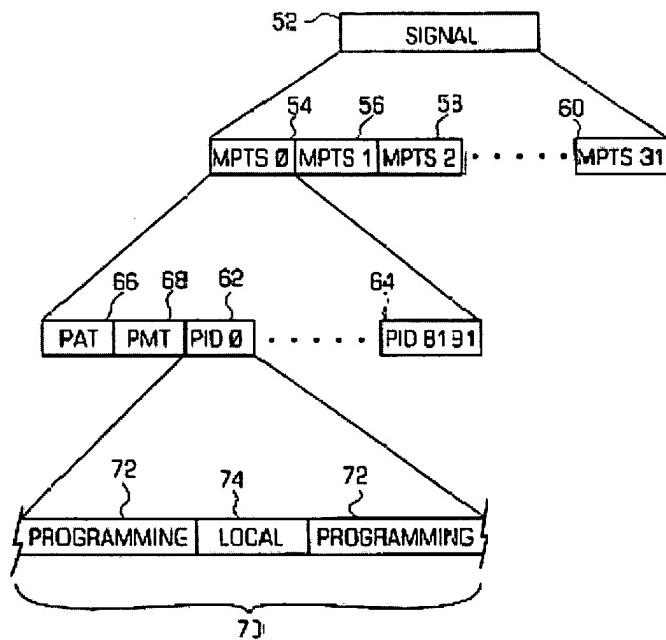
**(ii) Picco Does Not Show or Suggest Creating A Message Template**

In addition, claim 1 recites “creating a personalized message template comprising a plurality of slots in sequence.” One example of how this feature is accomplished is shown in FIG. 6, which shows a template having a plurality of slots in sequence. Based on the information about the viewer or any other suitable information, an appropriate segment will be selected for each slot to display. (*See* FIG. 6 of Applicants’ specification, reproduced below.)



**FIG. 6**

Contrary to the Examiner's suggestion on page 4 of the Office Action, FIG. 2 of Picco (or any other portion of Picco) does not show or suggest "a personalized message template that includes a video template and an audio template." Rather, as described above, Picco merely provides a data stream containing the television programming data and a local content space, where local content (i.e., advertisements) is inserted into that local content space. (See FIG. 2 of Picco, reproduced below, which illustrates a programming data stream and not a message template.)



**FIG. 2 of Picco**

Unlike Picco, claim 1 recites creating the personalized message template to help assemble a personalized message. It is the personalized message that may be inserted into the programming data stream. Picco, on the other hand, provides a static mapping table with designated local content spaces that provides programming to a television. Using the mapping table, the set-top terminal can only determine when a local content space is encountered in the programming data stream.

Accordingly, applicants respectfully submit that Picco fails to show or suggest "creating a personalized message template comprising a plurality of slots in sequence."

**(iii) Picco Does Not Show or Suggest Including Switch Times For Said Plurality of Synchronized Segments**

Claim 1 also recites “providing content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized segments.” Contrary to the Examiner’s suggestion on page 5 of the Office Action, for at least the following reasons, Picco does not show or suggest this element of applicants’ claim 1.

As explained above, Picco does not show or suggest creating a personalized message template or using that personalized message template to assemble a personalized message. In fact, the mapping table of Picco is merely capable of identifying where local content spaces are located in the programming data stream. When the set-top box detects that a local content space has been encountered, it inserts completed advertisements into that local content space.

Accordingly, because Picco fails to show creating a personalized message template or using that personalized message template to assemble a personalized message, applicants respectfully submit that Picco must also fail to show or suggest including “switch times for said plurality of synchronized segments.” As the Examiner points out, the “command and control data [of Picco] . . . instructs the processor within the set-top box how to insert the local content into the satellite data streams.” (*See* Picco, column 8, lines 36-39.) That is, the set-top box, using the command and control data, will determine which piece of local content is going to be inserted into the programming data stream. Because the Picco system is not assembling a personalized message, the command and control data will not include “information including switch times” for the different segments.

In view of the foregoing, applicants respectfully submit that independent claim 1 is allowable over Picco. Therefore, applicants respectfully request that the rejection of claim 1 be withdrawn by the Examiner.

Similarly, the remaining independent claims 16 and 19 are allowable for at least the same reasons. Therefore, applicants respectfully request that the rejection of independent claims 16 and 19 also be withdrawn by the Examiner.

Applicants respectfully submit that claims 2-7, 9-13, 15, 17, and 18, each of which depends from independent claims 1, are allowable for at least the same reasons that independent

claim 1 is patentable as set forth above. Therefore, applicants respectfully request that the Examiner withdraw the rejections of claims 2-7, 9-13, 15, 17, and 18.

**VII. The Rejection of Claim 8 Under 35 U.S.C. § 103(a)**

The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Picco in view of Ngo. Applicants respectfully traverse the Examiner's rejection.

Applicants respectfully submit that claim 8, which depends from independent claim 1, is allowable for at least the same reasons that independent claim 1 is patentable as set forth above. For at least this reason, applicant respectfully submits that the § 103 rejection should be withdrawn.

**VIII. The Rejection of Claim 14 Under 35 U.S.C. § 103(a)**

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Picco in view of Kunkel. Applicants respectfully traverse the Examiner's rejection.

Applicants respectfully submit that claim 14, which depends from independent claim 1, is allowable for at least the same reasons that independent claim 1 is patentable as set forth above. For at least this reason, applicant respectfully submits that the § 103 rejection should be withdrawn.

**IX. The Rejection of Independent Claims 20 and 21 under 35 U.S.C. § 102(e)**

The Examiner rejected claims 20 and 21 under 35 U.S.C. § 102(e) as being anticipated by Ngo et al. U.S. Patent No. 6,574,793 (hereinafter "Ngo"). The Examiner's rejection is respectfully traversed.

Common to applicants' amended claims 20 and 21 is the feature of "creating a plurality of different media segments, wherein said different media segments include incomplete sections of a complete non-interactive message."

Unlike applicants' invention, the advertisement in Ngo is interactive, where the viewer may select to view a different advertisement or a variant of an advertisement. In particular, Ngo provides systems and methods for downloading multiple advertisements to a set-top box, where a first preselected advertisement is displayed to the viewer. "The viewer may then request the next advertisement to be displayed by pointing to an icon on the television screen or pressing a next

ad button to on a remote control.” (See Ngo, column 7, lines 20-30.) “The viewer may also be presented with a menu that allows the viewer to select between additional variants to the advertisement.” (See Ngo, column 7, lines 33-35.) Nowhere in Ngo is it shown or suggested that the advertisements are non-interactive, as required by claims 20 and 21.

In view of the foregoing, applicants respectfully submit that independent claims 20 and 21 are allowable over Ngo. Therefore, applicants respectfully request that the rejection of claims 20 and 21 be withdrawn by the Examiner.

**X. New Counsel**

Applicants note that new counsel is handling the prosecution of the above-identified patent application and other applications for assignee. Accordingly, applicants have enclosed herewith a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address form. Please direct all further correspondence to:

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Wilmer Cutler Pickering Hale and Dorr LLP  
399 Park Avenue  
New York, New York 10022

## CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicants' best attempt at providing one or more definitions of what the applicants believe to be suitable patent protection. In addition, the present claims provide the

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intended scope of protection that applicants are seeking for this application. Therefore, no estoppel should be presumed, and applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

## **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

WILMER CUTLER PICKERING  
HALE AND DORR LLP

Date: January 23, 2006



Philip R. Polk  
Registration No. 51,176  
Agent for Applicants

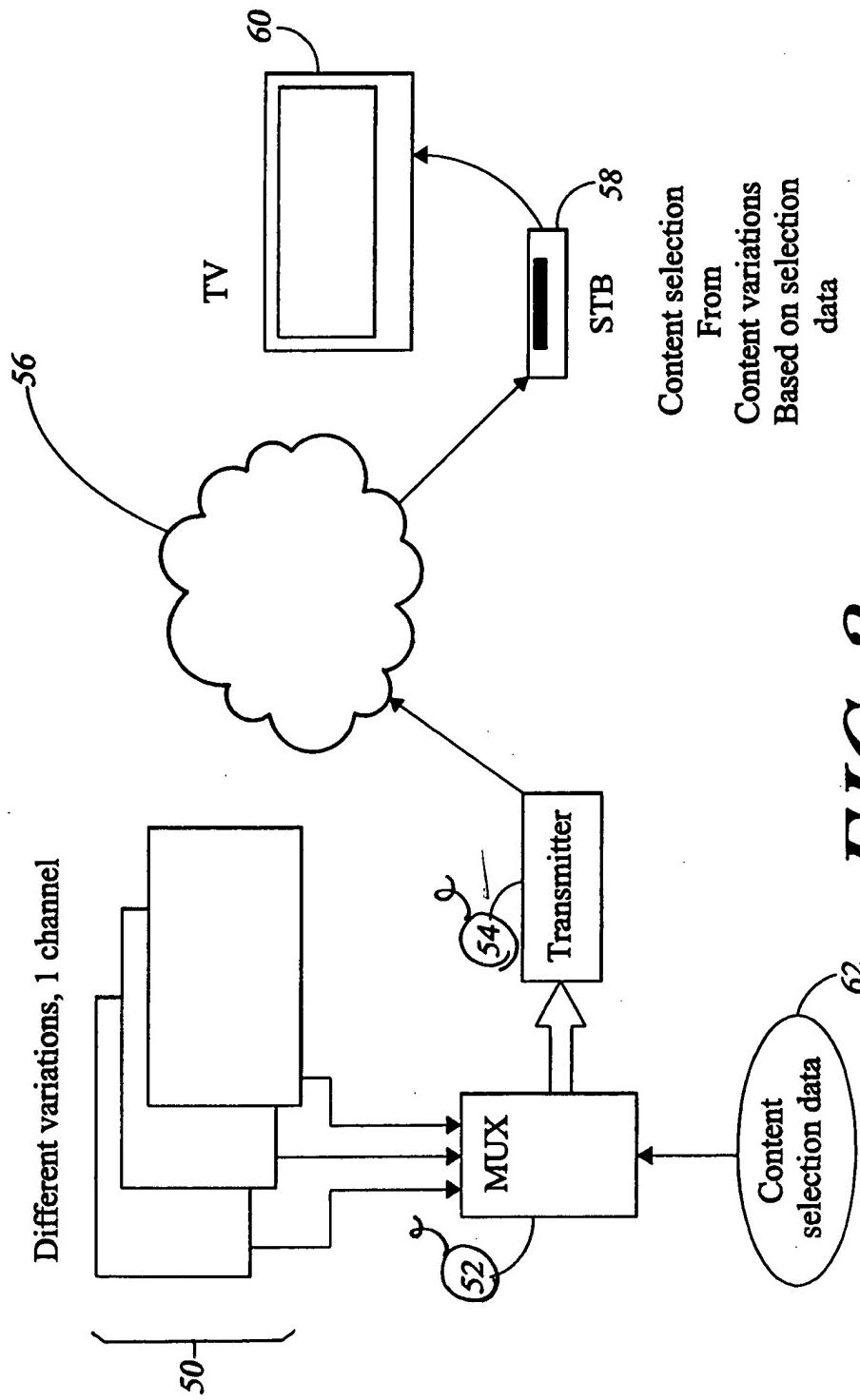
Wilmer Cutler Pickering  
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399 Park Avenue  
New York, NY 10022  
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Fax. 212-230-8888  
Customer No. 28089



Inventor : Seth Haberman et al. Express Mail Label No. EV 735323527US  
Application No. : 09/841,465 Filed: April 24, 2001  
Title: SYSTEM AND METHOD FOR SIMULTANEOUS BROADCAST FOR PERSONALIZED MESSAGES

ANNOTATED SHEET

2/13



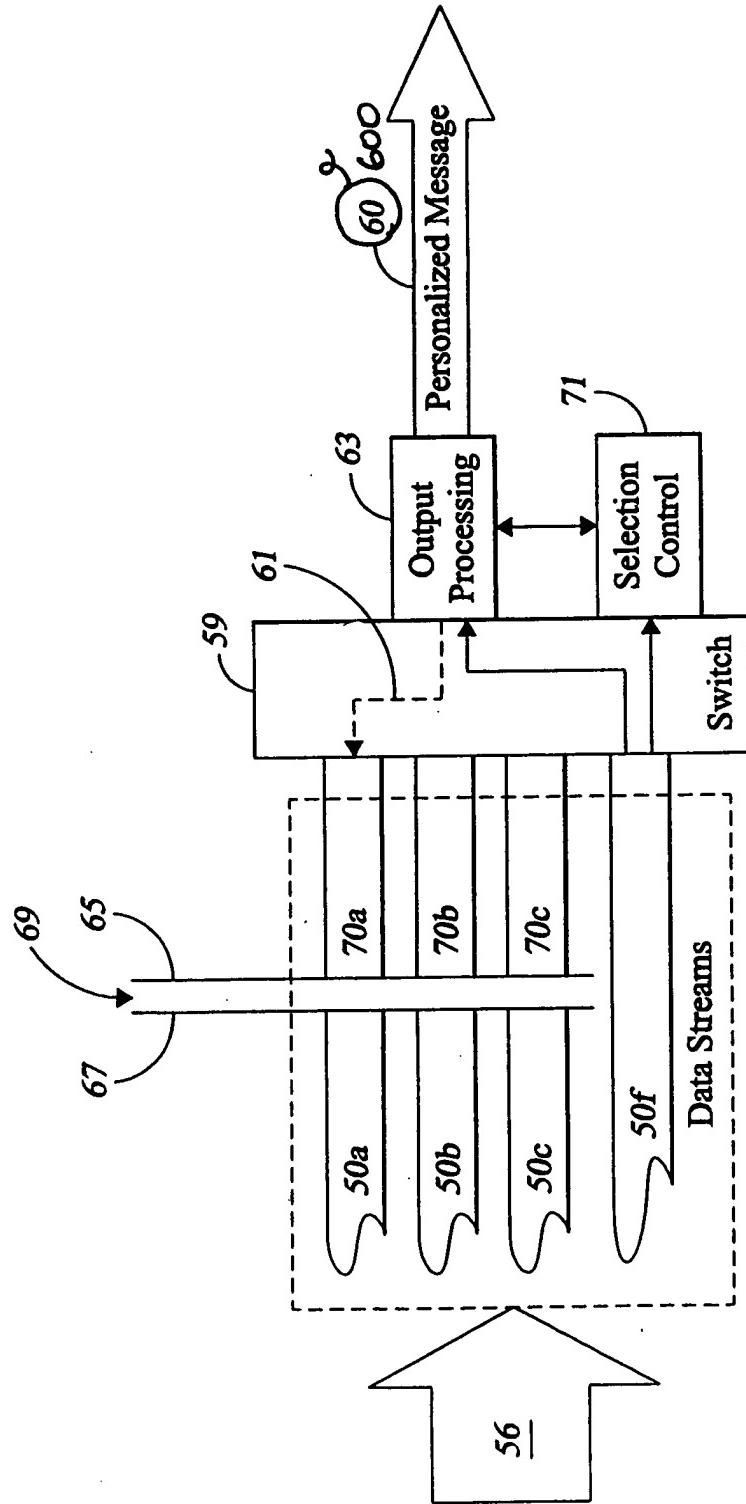
**FIG. 2**



Inventor : Seth Haberman et al. Express Mail Label No. EV 735323527US  
Application No. : 09/841,465 Filed: April 24, 2001  
Title: SYSTEM AND METHOD FOR SIMULTANEOUS BROADCAST FOR PERSONALIZED MESSAGES

ANNOTATED SHEET

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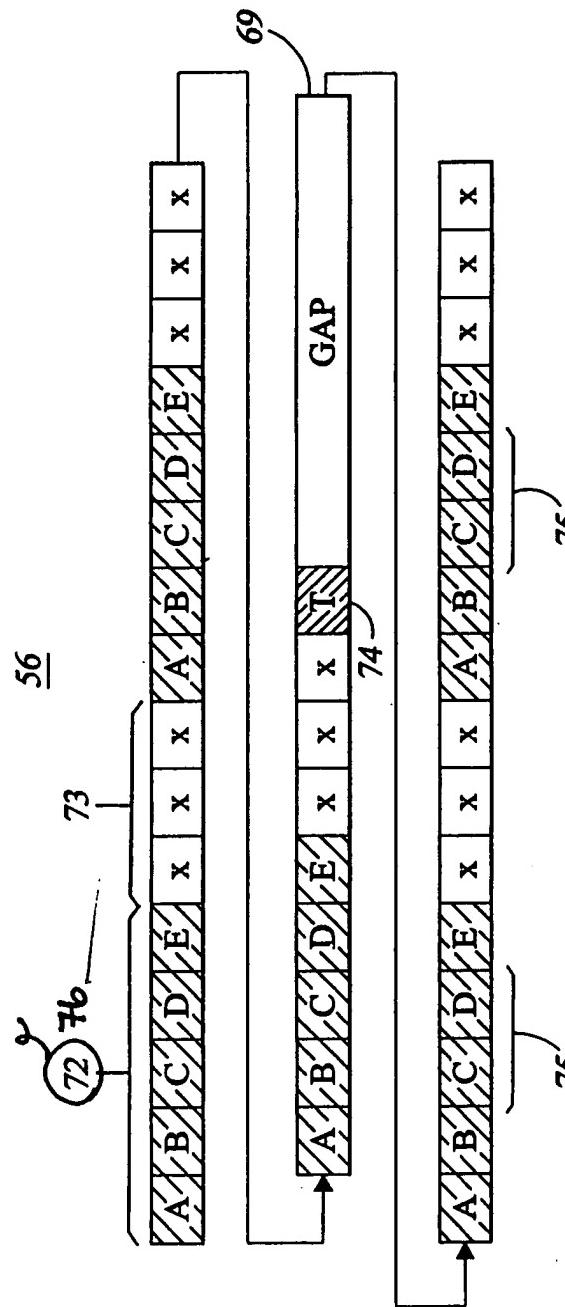




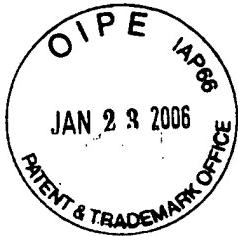
Inventor : Seth Haberman et al. Express Mail Label No. EV 735323527US  
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Title: SYSTEM AND METHOD FOR SIMULTANEOUS BROADCAST FOR PERSONALIZED MESSAGES

ANNOTATED SHEET

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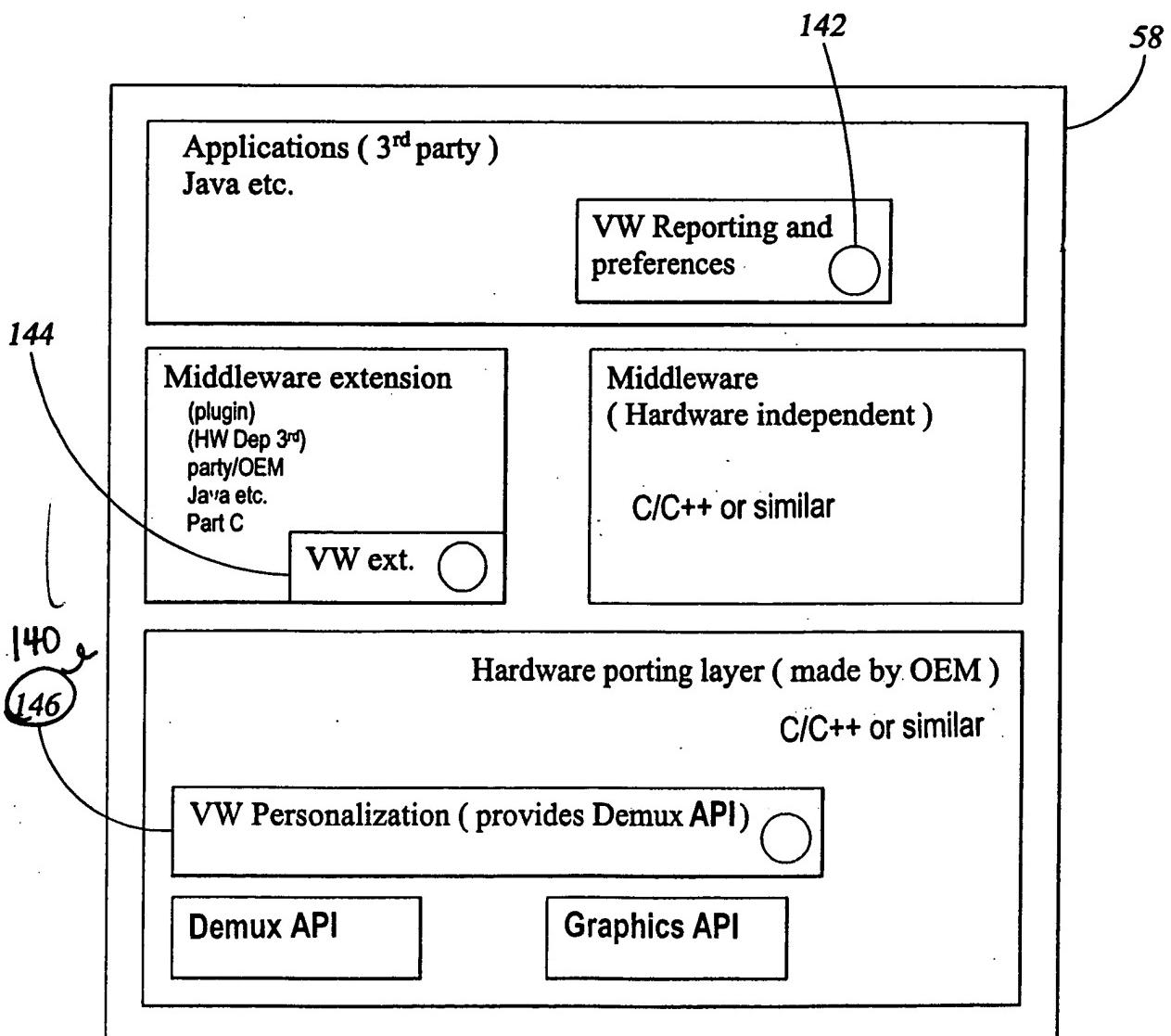


*FIG. 8*



Inventor : Seth Haberman et al. Express Mail Label No. EV 735323527US  
 Application No. : 09/841,465 Filed: April 24, 2001  
 Title: SYSTEM AND METHOD FOR SIMULTANEOUS BROADCAST FOR PERSONALIZED MESSAGES

ANNOTATED SHEET  
 10/13



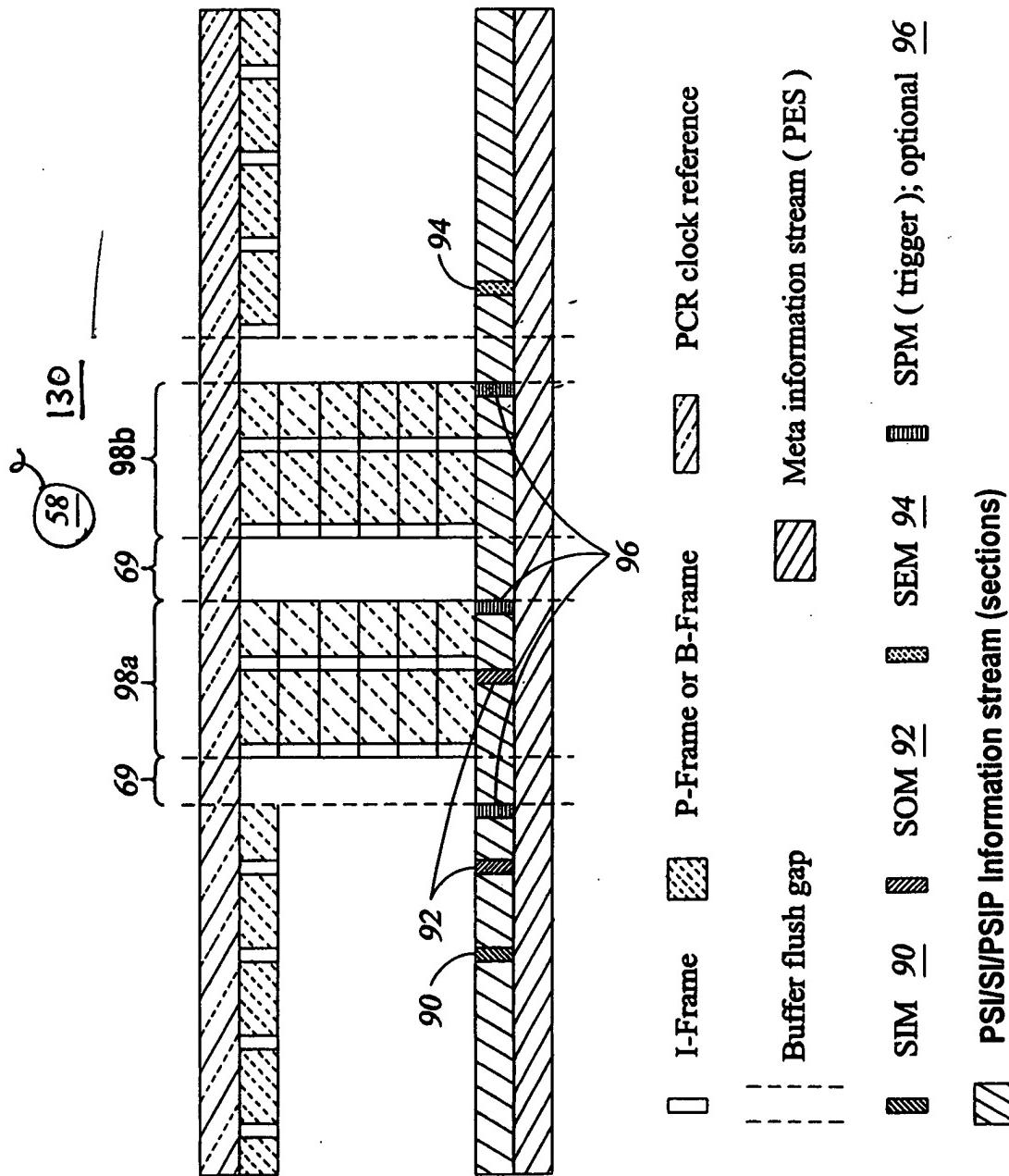
**FIG. 10**



Inventor : Seth Haberman et al. Express Mail Label No. EV 735323527US  
 Application No. : 09/841,465 Filed: April 24, 2001  
 Title: SYSTEM AND METHOD FOR SIMULTANEOUS BROADCAST FOR PERSONALIZED MESSAGES

ANNOTATED SHEET

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*FIG. 13*